

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

EASY SPIRIT, LLC,

Plaintiff,

-against-

SKECHERS U.S.A., INC. and
SKECHERS U.S.A., INC. II,

Defendants.

Civil Action No.

COMPLAINT

Plaintiff, Easy Spirit, LLC (“Easy Spirit” or “Plaintiff”) by and through its attorneys, Peroff Saunders, P.C., for its complaint against Defendants, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II, (collectively “Skechers” or “Defendants”) alleges as follows:

NATURE OF THE ACTION

1. This is an action for: (i) infringement of Plaintiff’s registered trademark under 15 U.S.C § 1114; (ii) false designation of origin in violation of 15 U.S.C. § 1125(a); (iii) common law trademark infringement; (iv) common law trade dress infringement; and (v) violation of Section 360-1 of the New York General Business Law. Easy Spirit seeks injunctive relief and damages.

JURISDICTION AND VENUE

2. This Court has jurisdiction over the subject matter of this action pursuant to 15 U.S.C. § 1121, 28 U.S.C. §§ 1331 and 1338. This Court has supplemental jurisdiction over the New York State claims pursuant to 28 U.S.C. § 1367(a), as the New York State law claims

asserted herein are so related to the Lanham Act claims as to form part of the same case or controversy.

3. This Court has personal jurisdiction over the Defendants because they transact business within the State of New York and/or because a substantial part of the events giving rise to these claims occurred in this judicial district, and the Defendants have minimum contacts with the forum.

4. Venue is properly founded in this judicial district pursuant to 28 U.S.C. § 1391(b) and (c) because Defendants are subject to personal jurisdiction within this judicial district and/or because a substantial part of the events giving rise to the claims occurred in this judicial district.

PARTIES

5. Easy Spirit, LLC is a limited liability company organized under the laws of the State of Delaware, with its principal place of business at 777 W. Putnam Avenue, Greenwich, Connecticut 06830.

6. Upon information and belief, Skechers U.S.A., Inc. is a corporation organized under the laws of the State of Delaware with its principal place of business at 228 Manhattan Beach Blvd., Manhattan Beach, California 90266.

7. Upon information and belief, Skechers U.S.A., Inc. II is a corporation organized under the laws of the State of Virginia with its principal place of business at 228 Manhattan Beach Blvd., Manhattan Beach, California 90266.

PLAINTIFF EASY SPIRIT AND THE TRAVELTIME SHOE

8. The Easy Spirit shoe brand originated in 1985. Easy Spirit creates and sells high quality women's footwear that is designed to be extraordinary comfortable. The Easy Spirit core mission is to create ultra-comfortable footwear for life's everyday activities, whether work,

leisure or sports. Over the past 35 years, Easy Spirit has developed an outstanding reputation for selling women's footwear that is synonymous with comfort. Easy Spirit continually innovates to design and develop footwear that is lighter, softer and easier to wear than ever before.

9. Plaintiff Easy Spirit, LLC is the successor-in-interest and the current owner of all Easy Spirit intellectual property through an asset acquisition which occurred on December 30, 2016, as well as through subsequent assignments of Easy Spirit trademarks and other intellectual property.

10. In 2004 Easy Spirit introduced the TRAVELTIME shoe. The Traveltime shoe was a revolutionary design that provides ease of wear and exceptional comfort. The shoe is a light-weight slip-on mule style with an open back, designed for maximum comfort and easy wearing.



11. The Traveltime shoe was an instant success. In 2006, the Traveltime shoe was the number one selling shoe of all brands sold in department stores.

12. To date, Easy Spirit has sold over 11,000,000 pairs of Traveltime shoes. In 2016, unit sales of the Traveltime shoe ranked 43 of all women's fashion shoes sold in the United States, according to industry data. Since then, the Traveltime shoe has remained as a

consistently high performing brand, with unit rankings for the past three years ranging from 58-71 of all women's fashion shoes sold. The Traveltime shoe has been Easy Spirit's top selling shoe for the past ten years.

13. Easy Spirit has undertaken substantial efforts to advertise and promote its Traveltime shoes. These include in-store promotion items, advertising in major publications including the New York Times and Redbook, and on e-commerce/social media sites. Examples of Easy Spirit's Traveltime advertising and promotional materials are attached as **Exhibit 1**.

14. Easy Spirit extensively promotes the Traveltime shoe on its website. Exemplary screenshots are attached as **Exhibit 2**.

15. As early as at least 2006, Easy Spirit launched extensive mailer and in-store initiatives for Macy's department stores that included the Traveltime shoes. Examples are attached as **Exhibit 3**.

16. The Easy Spirit Traveltime shoes are also advertised in and sold by major shoe catalog companies, including Masseys and Maryland Square. Pages from current Masseys and Maryland Square catalogs are attached as **Exhibit 4**.

17. To further promote its Traveltime shoes, Easy Spirit created videos that included the popular Traveltime shoe as a part of a national marketing campaign for the Easy Spirit brand. Easy Spirit purchased national television commercials for four-week runs in the Fall and Spring of 2018 that showcased the Traveltime shoe, including commercials that ran during a sponsored segment of ABC network's *The View* and on CBS and the Hallmark Channel. For its Spring 2019 Campaign, Easy Spirit is featuring its Traveltime shoes through videos shown on its website and social media sites. The videos were also used for paid social media advertising. Screenshots from the promotional videos are attached as **Exhibit 5**.

18. As a result of the outstanding success of the Traveltime shoe, the Traveltime name has come to symbolize extraordinary goodwill, all of which is owned exclusively by Plaintiff Easy Spirit.

19. In 2014, the Traveltime brand name was registered as a trademark on the Principal Register of the U.S. Patent and Trademark Office, under U.S. Registration No. 4,505,161. A true and correct copy of the TRAVELTIME trademark registration is attached as **Exhibit 6**. The TRAVELTIME trademark registration is subsisting and fully enforceable. (The date of first use and first use in commerce of TRAVELTIME is incorrectly set forth in the registration; however, this has no effect on Easy Spirit's existing common law rights in and to the trademark prior to the date in the registration).

20. Easy Spirit has utilized the same unique design elements for the Traveltime shoe from its introduction to the present. As a result of the extraordinary commercial success of the shoe, and through Plaintiff's efforts, the overall design and appearance of the Traveltime shoe indicates to purchasers the source of the shoe, and distinguishes it from those of competitors. The unique combination of design elements of the Traveltime shoe constitutes a protectable trade dress under federal and New York state law.

21. The elements of the Traveltime trade dress are:

- (i) a slip-on, clog-style upper;
 - (ii) a distinctive "swirl" mid-sole that runs from the base of the toe cap, gradually widening as it flows to the heel;
 - (iii) an indented curved line along the midsole from the front to the heel;
- another indented line on the rear of the shoe;

- (iv) a combined contoured midsole/outsole with an arch that creates an open area between the outsole and heel;
 - (v) the rubber outsole extending up from the bottom of the shoe to the front of the shoe to form a bumper; and
 - (vi) four circular design elements on the midsole at the heel segment.
- (See diagram below).

These distinctive elements, in combination, are hereinafter referred to as the “Traveltime Trade Dress.”



22. The Traveltime Trade Dress symbolizes extraordinary goodwill, all of which is owned exclusively by Easy Sprit.

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DEFENDANTS' SKECHERS ACTS OF INFRINGEMENT

23. Defendants recently introduced and sell a shoe that Skechers calls the “Commute Time.” The shoe is a blatant copy of the Easy Spirit Traveltime. The Skechers Commute Time shoe emulates the Traveltime Trade Dress.



24. The Skechers Commute Time shoe contains the identical unique combination of five of the six elements of the Traveltime Trade Dress and a slight modification of the sixth element. Specifically, the Skechers Commute Time shoe has:

- (i) a slip-on, clog-style upper;
- (ii) a distinctive “swirl” mid-sole that runs from the base of the toe cap, gradually widening as it flows to the heel;
- (iii) an indented curved line along the midsole from the front to the heel; another indented line on the rear of the shoe;
- (iv) a combined contoured midsole/outsole with an arch that creates an open area between the outsole and heel;
- (v) the rubber outsole extending up from the bottom of the shoe to the front of the shoe to form a bumper; and

(vi) two (instead of four) oblong (instead of round) design elements on the midsole at the heel segment (i.e., the same location as the four design elements on the Traveltime shoe).

25. Skechers' copying of the Traveltime Trade Dress is a blatant effort to misappropriate the goodwill symbolized by the Traveltime Trade Dress and is likely to cause confusion and deception.

26. In addition to copying and using the Traveltime Trade Dress, Skechers has copied specific Traveltime shoe styles, including print patterns and colored trim.

Easy Spirit	Skechers
	
	

Of the multitude of colors, print patterns and trim adornment available for use on a shoe, Skechers has chosen to use the same elements, in addition to the Traveltime Trade Dress, to create shoes with the same overall appearance as the Easy Spirit Traveltime shoes. Skechers' blatant and overt copying of Easy Spirit's Traveltime shoe styles demonstrates an intent to come as close as possible and misappropriate the vast goodwill associated with the Traveltime Trade Dress.

27. Skechers has relentlessly continued to copy Easy Spirit shoe styles. Another popular style in the Traveltime family is the Easy Spirit Instep shoe. The shoe has a distinctive "keyhole" cut into the side of the upper. Skechers recently introduced the "Commute Time - Rideshare" with the same upper and overall design elements, including the Traveltime Trade Dress and the "keyhole" on the side of the upper.



28. The blatant copying by Skechers of the Easy Spirit Traveltime Trade Dress constitutes willful acts that are intended to cause confusion and deception in the marketplace.

29. Any *de minimis* differences in the design elements between the Skechers' Commute Time and the Easy Spirit Traveltime shoes are, upon information and belief, intended to be so subtle as to create the same overall impression as the Traveltime Trade Dress.

30. The stark similarity between the Skechers' Commute Time shoe and Easy Spirit Traveltime shoe is not coincidence, but an overt and reckless misappropriation of Easy Spirit's intellectual property, to reap where Skechers has not sown.

31. Dramatically exacerbating the effects of its willful trade dress infringement, Skechers selected a name and mark for the shoe that has the same connotation and commercial impression as TRAVELTIME – "Commute Time." See **Exhibit 7**.

32. "Commute Time" is so similar to Traveltime, as applied to the same category of goods, as to be likely to cause confusion among consumers and the public.

33. "Commute" is defined by Merriam-Webster as "**to travel** back and forth regularly (as between a suburb and a city)." *Merriam-Webster Online Dictionary*. 2019. <https://www.merriam-webster.com/dictionary/commute> (April 5, 2019).

34. The combination of blatantly copying the Traveltime Trade Dress and selecting a name that comes as close as possible to TRAVELTIME demonstrates a willful, intentional and wanton effort to duplicate the Traveltime shoe, ride on Easy Spirit's reputation, misappropriate Easy Spirit's goodwill and cause confusion and deception in the marketplace and among the public.

35. Upon information and belief, Skechers' adoption and use of the Traveltime Trade Dress and Commute Time trademark were done with intent to cause confusion.

36. The foregoing unlawful acts of Skechers are causing irreparable harm to Easy Spirit and the goodwill symbolized by the Traveltime Trade Dress and the TRAVELTIME trademark.

FIRST CLAIM FOR RELIEF

(Trademark Infringement Under Lanham Act 15 U.S.C. § 1114(1)(a))

37. Easy Spirit repeats and realleges each of the above allegations as if fully set forth herein.

38. Plaintiff is the owner of U.S. Trademark Registration Number 4,505,161. The registration is in full force and effect.

39. Defendants, without authorization from Easy Spirit, have used and are continuing to use a spurious designation that is so similar to Easy Spirit's registered trademark as to be likely to cause confusion.

40. Defendants' sale of shoes bearing the spurious copy of Easy Spirit's registered trademark is likely to cause confusion, or to cause mistake, or to deceive consumers into believing that Defendants' products are Plaintiff's or are authorized or approved by Plaintiff.

41. Defendants' conduct constitutes trademark infringement in violation of 15 U.S.C. § 1114(1)(a).

42. Upon information and belief, Defendants' infringement of Plaintiff's trademark was and is willful and intentional.

43. Upon information and belief, by their acts, Defendants have made and will continue to make substantial profits and gains to which they are not entitled in law or equity.

44. Upon information and belief, Defendants intend to continue their infringing acts and will continue to infringe Plaintiff's registered trademark, unless restrained by this Court.

45. Defendants unlawful acts have caused, and will continue to cause, irreparable harm to Plaintiff. Plaintiff has no adequate remedy at law.

SECOND CLAIM FOR RELIEF

(False Designation of Origin, 15 U.S.C. § 1125(a))

46. Easy Spirit repeats and realleges each of the above allegations as if fully set forth herein.

47. The Traveltime designation is inherently distinctive and has acquired distinctiveness.

48. The Traveltime designation indicates the source of the Plaintiff's shoes.

49. The Traveltime Trade Dress is nonfunctional and has acquired distinctiveness.

50. The Traveltime Trade Dress indicates the source of Plaintiff's Traveltime shoes.

51. Defendants' advertisement, promotion, sale and offering for sale of their Commute Time shoes is intended and is likely to confuse, mislead, deceive consumers, the public, and the trade as to the origin, source, sponsorship, or affiliation of Defendants' shoes and is likely to cause the public to believe erroneously that such products have been authorized, sponsored, approved, endorsed, or licensed by Plaintiff, or that Plaintiff is in some way affiliated with Defendants.

52. Defendants' acts constitute false designation of origin and false and misleading descriptions and representations of fact, all in violation of 15 U.S.C. § 1125(a).

53. Upon information and belief, Defendants' misappropriation and infringement of Plaintiff's TRAVELTIME trademark and Traveltime Trade Dress was and is willful and intentional.

54. Upon information and belief, by their acts, Defendants have made and will continue to make substantial profits and gains to which they are not entitled in law or equity.

55. Upon information and belief, Defendants intend to continue their infringing acts, and will continue to infringe Plaintiff's Traveltime Trade Dress unless restrained by this Court.

56. Defendants' unlawful acts have caused, and will continue to cause, irreparable harm to Plaintiff. Plaintiff has no adequate remedy at law.

THIRD CLAIM FOR RELIEF

(Common Law Trademark Infringement)

57. Easy Spirit repeats and realleges each of the above allegations as if fully set forth herein.

58. The designation Traveltime is inherently distinctive and functions to indicate the source of Easy Spirit's goods.

59. The designation Traveltime constitutes a trademark under the common law of the state of New York.

60. Defendants' use of the mark Commute Time for shoes is likely to cause confusion as to the source of the goods and to lead consumers into mistakenly believing that the goods emanate from Easy Spirit or are sponsored or endorsed by Plaintiff.

61. Defendants' activities constitute trademark infringement under the common law of the State of New York.

62. Upon information and belief, Defendants' adoption and use of their Commute Time mark was done with the intention of causing public confusion.

63. Defendants' use of their Commute Time mark, unless restrained by this Court, will lead the public to believe that there is a connection or association between Defendants and Plaintiff, when in fact, there is none.

64. Defendants' unlawful acts have caused, and will continue to cause, irreparable harm to Plaintiff. Plaintiff has no adequate remedy at law.

FOURTH CLAIM FOR RELIEF

(Common Law Trade Dress Infringement)

65. Easy Spirit repeats and realleges each of the above allegations as if fully set forth herein.

66. The overall configuration and appearance of Plaintiff's Traveltime shoe are recognized by consumers and the public as indicating the source of the goods.

67. The overall configuration and appearance of Plaintiff's Traveltime shoe are non-functional.

68. The overall configuration and appearance of Plaintiff's Traveltime shoe have acquired secondary meaning in the marketplace.

69. The overall configuration and appearance of Plaintiff's Traveltime shoe constitutes a protectable trade dress owned exclusively by Easy Spirit under the common law of the State of New York.

70. The advertising and sale of Defendants' Commute Time shoes is likely to cause confusion as to the source of the goods and lead consumers into mistakenly believing that the goods emanate from Easy Spirit or are sponsored and endorsed by Plaintiff.

71. Upon information and belief, Defendants' adoption and use of the overall design of their Commute Time shoe was done with the intention of causing public confusion.

72. Defendants' activities were undertaken with a wanton disregard for Plaintiff's trade dress rights.

73. Defendants' activities constitute trade dress infringement under the common law of the State of New York.

74. Defendants' use of a confusingly similar trade dress for their Commute Time shoe to that of the Traveltime Trade Dress, unless restrained by this Court, will lead the public to believe that there is a connection or association between Defendants and Plaintiff, when in fact, there is none.

75. Defendants' unlawful acts have caused, and will continue to cause, irreparable harm to Plaintiff. Plaintiff has no adequate remedy at law.

FIFTH CLAIM FOR RELIEF

(Unfair Business Practice Under N.Y. Gen. Bus. Law § 360-1)

76. Easy Spirit repeats and realleges each of the above allegations as if fully set forth herein.

77. Plaintiff's TRAVELTIME trademark is distinctive and has acquired secondary meaning in the marketplace.

78. Defendants' acts are likely to dilute, have diluted, and, unless enjoined by this Court, will continue to dilute the distinctive quality of Plaintiff's Mark.

79. As a direct and proximate result of Defendants' willful and wonton acts and conduct, Plaintiff's reputation and goodwill have been damaged.

80. Defendants' acts and conduct have caused irreparable harm to Plaintiff and to Plaintiff's reputation and goodwill, and will continue to do so unless restrained by this Court. Plaintiff has no adequate remedy at law.

WHEREFORE, Plaintiff respectfully prays for judgment against Defendants as follows:

- A. That the Court enter an injunction ordering that Defendants, their agents, servants, employees, and all other persons in privity or acting in concert with them be enjoined and restrained from:
 - (a) using Commute Time or any reproduction, counterfeit, copy, or colorable imitation of the TRAVELTIME trademark to identify any goods not authorized by Plaintiff;
 - (b) using the Traveltime Trade Dress in connection with any footwear products;
 - (c) engaging in any course of conduct likely to cause confusion, deception or mistake, or to injure Plaintiff's business reputation or weaken the distinctive quality of the TRAVELTIME trademark or Traveltime Trade Dress;
 - (d) using a false description or representation including designs and other symbols falsely describing or representing Defendants' unauthorized shoes as being manufactured or sold by Plaintiff or sponsored by or associated with Plaintiff;
 - (e) using any simulation, reproduction, counterfeit, copy or colorable imitation of the TRAVELTIME trademark in connection with the promotion, advertisement, display, and/or sale of shoes as they relate or connect, or tend to relate or connect in any way to Plaintiff, or to its products owned, sponsored or approved by, or connected with Plaintiff; and
 - (f) making any statement or representation whatsoever, or using any false designation of origin or false description, or performing any act, which can or is likely to lead the trade or public, or individual members thereof, to believe that Defendants' shoes are in any way associated or connected with Plaintiff.
- B. Ordering that Defendants, within thirty (30) days of Judgment, file and serve Plaintiff with a sworn statement setting forth in detail the manner in which Defendants have complied with the injunction pursuant to 15 U.S.C. § 1116(a).
- C. Ordering that Defendants deliver up for destruction to Plaintiff all unauthorized goods bearing any simulation, reproduction, counterfeit, copy or colorable imitation of Plaintiff's trademark and/or trade dress, and all plates, molds, matrices and other means of production of same pursuant to 15 U.S.C. § 1118.

- D. Ordering Defendants to recall from any distributors and retailers any infringing products, including all advertising, promotional and marketing materials therefore, as well as means of making same.
- E. Ordering Defendants to deliver to Plaintiff for destruction or other disposition all remaining inventory of all infringing products, including all advertising, promotional and marketing materials therefore, as well as means of making same.
- F. Ordering an accounting by Defendants of all gains, profits and advantages derived from their wrongful acts.
- G. Awarding Plaintiff all of Defendants' profits and all damages sustained by Plaintiff as a result of Defendants' wrongful acts, and such other compensatory damages in an amount to be proven at trial pursuant to 15 U.S.C. § 1117(a).
- H. Awarding treble damages in the amount of Defendants' profits or Plaintiff's damages, whichever is greater, for willful infringement pursuant to 15 U.S.C. § 1117(b).
- I. Awarding Plaintiff punitive damages under its state law claims.
- J. Ordering that Plaintiff recover the costs of this action, together with reasonable attorney's fees and prejudgment interest in accordance with 15 U.S.C. § 1117.
- K. Awarding to Plaintiff such other and further relief as the Court may deem just and proper.

Dated: New York, New York
April 12, 2019

Respectfully submitted,

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